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**TRANSMITTAL  
FORM**

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Total Number of Pages in This Submission

Application Number	10/606,700
Filing Date	June 23, 2004
First Named Inventor	Chang-Hsing Liang et al.
Art Unit	1623
Examiner Name	Preslev, Elli
Attorney Docket Number	8024-004-US

**ENCLOSURES (Check all that apply)**

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Remarks

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	Catalyst Law Group, APC		
Signature			
Printed name	Jeff Landes, Esq.		
Date	October 12, 2004	Reg. No.	55,355

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10/13/04

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**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Chang-Hsing Liang et al.

Examiner: Preslev, Elli

Serial No.: 10/606,700

Art Unit: 1623

Filed: June 26, 2003

Attorney Ref. No.: 8024-004-US

Title: NEW AMINOGLYCOSIDE  
ANTIBIOTICS AS NOVEL ANTI-  
INFECTIVE AGENTS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO RESTRICTION REQUIREMENT**

Dear Commissioner:

In response to the Restriction Requirement of September 17, 2004,  
Applicant responds as follows:

I. **THE RESTRICTION REQUIREMENT**

Restriction of the following inventions was required under 35 U.S.C. §  
121:

Group I is claims 1-2 and 5-8, drawn to aminoglycosides, classified in  
class 536, subclass 17.2.

Group II is claims 3-4, drawn to cyclohexyl derivatives, classified in class 564, subclass 1+.

The inventions of groups I and II were stated to be mutually exclusive in an intermediate-final product relationship. These inventions were stated to be distinct because the intermediate product was useful to make other products.

## II APPLICANT'S RESPONSE

Applicant elects the invention of Group I, claims 1-2 and 5-8, drawn to the aminoglycosides, for prosecution on the merits, with traverse.

The Restriction Requirement is respectfully traversed on the following grounds:

The Examiner has not met the burden for demonstrating the necessity for restriction. M.P.E.P. § 803 requires for restriction both: (1) that the inventions are independent or distinct as claimed; and (2) that there would exist a "serious burden" on the Examiner if all of the claims were examined in one application.

These requirements have not been met. Firstly, there is no demonstration that a "serious burden" on the Examiner would exist.

The subject matter of the inventions is sufficiently interrelated that no serious burden on the Examiner would exist if all of the claims were examined on the merits. This is because the art involved, if any relevant art exists, largely overlaps. For example, publications describing methods of synthesizing aminoglycoside products of the current invention will invariably report on intermediates involved in said synthesis. Thus, there is not basis for restricting the claims based on the intermediate-final product relationship. Accordingly, the inventions of Groups I and II should be examined together.

Applicant does not traverse the restriction on the basis of a lack of patentable distinctiveness. Rather, Applicant traverses the restriction requirement on the relatedness of the subject matter comprising Groups I and II. Applicant, who is

presenting this information in a unitary manner in one patent application, should not be penalized by restriction when the subject matter is so clearly related. More significantly, the art required to search these groups is so closely related that there does not exist a "serious burden" on the Examiner if searched and examined in a single application. The determination of the existence or non-existence of a "serious burden" should not be made according to arbitrary principles, but should reflect the actual state of the art.

Accordingly, the Restriction Requirement is respectfully traversed. The Examiner is therefore respectfully requested to withdraw the Restriction Requirement and examine all of the claims on the merits.

### III. CONCLUSION

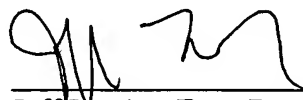
In conclusion, Applicant elects the invention of Group I, claims 1-2 and 5-8, drawn to aminoglycosides, for prosecution on the merits, with traverse.

The Restriction Requirement is respectfully traversed, and Applicant requests that the Restriction Requirement be withdrawn.

Respectfully Submitted,

Date: October 12<sup>th</sup>, 2004

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